



PTO/SB/21 (05-03)

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| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 09/540,558 | |
| | Filing Date | 03/31/2000 | |
| | First Named Inventor | Tom Flanagan | |
| | Art Unit | 2143 | |
| | Examiner Name | Joseph E. Avellino | |
| Total Number of Pages in This Submission | 37 | Attorney Docket Number | TI-30384 |

| ENCLOSURES (Check all that apply) | | |
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| Date | 7-02-04 |

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PTO/SB/17 (05-03)

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FEE TRANSMITTAL for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 165

Complete if Known

| | |
|----------------------|--------------------|
| Application Number | 09/540,558 |
| Filing Date | 03/31/2000 |
| First Named Inventor | Tom Flanagan |
| Examiner Name | Joseph E. Avellino |
| Art Unit | 2143 |
| Attorney Docket No. | TI-30384 |

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit
Account
Number
Deposit
Account
Name

20-0668

Texas Instruments

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments☒ Charge any additional fee(s) during the pendency of this application☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|------------------------|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1001 | 750 | 2001 | 375 | Utility filing fee | |
| 1002 | 330 | 2002 | 165 | Design filing fee | |
| 1003 | 520 | 2003 | 260 | Plant filing fee | |
| 1004 | 750 | 2004 | 375 | Reissue filing fee | |
| 1005 | 160 | 2005 | 80 | Provisional filing fee | |
| SUBTOTAL (1) | | | | | (\$) |

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| | | | | | | | |
|--------------------|--|---------|--|---|--|---|--|
| Total Claims | | -20** = | | X | | = | |
| Independent Claims | | -3** = | | X | | = | |
| Multiple Dependent | | | | | | = | |

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|--|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1202 | 18 | 2202 | 9 | Claims in excess of 20 | |
| 1201 | 84 | 2201 | 42 | Independent claims in excess of 3 | |
| 1203 | 280 | 2203 | 140 | Multiple dependent claim, if not paid | |
| 1204 | 84 | 2204 | 42 | ** Reissue independent claims over original patent | |
| 1205 | 18 | 2205 | 9 | ** Reissue claims in excess of 20 and over original patent | |
| SUBTOTAL (2) | | | | | (\$) |

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Small Entity

| Fee Code | Fee (\$) | Fee Code | Fee (\$) | Fee Description | Fee Paid |
|----------|----------|----------|----------|--|----------|
| 1051 | 130 | 2051 | 65 | Surcharge - late filing fee or oath | |
| 1052 | 50 | 2052 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 | 130 | 1053 | 130 | Non-English specification | |
| 1812 | 2,520 | 1812 | 2,520 | For filing a request for ex parte reexamination | |
| 1804 | 920* | 1804 | 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 | 1,840* | 1805 | 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 | 110 | 2251 | 55 | Extension for reply within first month | |
| 1252 | 410 | 2252 | 205 | Extension for reply within second month | |
| 1253 | 930 | 2253 | 465 | Extension for reply within third month | |
| 1254 | 1,450 | 2254 | 725 | Extension for reply within fourth month | |
| 1255 | 1,970 | 2255 | 985 | Extension for reply within fifth month | |
| 1401 | 320 | 2401 | 160 | Notice of Appeal | |
| 1402 | 320 | 2402 | 160 | Filing a brief in support of an appeal | 165 |
| 1403 | 280 | 2403 | 140 | Request for oral hearing | |
| 1451 | 1,510 | 1451 | 1,510 | Petition to institute a public use proceeding | |
| 1452 | 110 | 2452 | 55 | Petition to revive - unavoidable | |
| 1453 | 1,300 | 2453 | 650 | Petition to revive - unintentional | |
| 1501 | 1,300 | 2501 | 650 | Utility issue fee (or reissue) | |
| 1502 | 470 | 2502 | 235 | Design issue fee | |
| 1503 | 630 | 2503 | 315 | Plant issue fee | |
| 1460 | 130 | 1460 | 130 | Petitions to the Commissioner | |
| 1807 | 50 | 1807 | 50 | Processing fee under 37 CFR 1.17(q) | |
| 1806 | 180 | 1806 | 180 | Submission of Information Disclosure Stmt | |
| 8021 | 40 | 8021 | 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 | 750 | 2809 | 375 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 1810 | 750 | 2810 | 375 | For each additional invention to be examined (37 CFR 1.129(b)) | |
| 1801 | 750 | 2801 | 375 | Request for Continued Examination (RCE) | |
| 1802 | 900 | 1802 | 900 | Request for expedited examination of a design application | |

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 165

SUBMITTED BY

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(Attorney/Agent)

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(Complete if applicable)

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Signature

Date

7-2-04

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BOARD OF
PATENT APPEALS AND INTERFERENCES**

In re patent application of

TOM FLANAGAN

Application No.09/540,558

Group Art Unit: 2143

Filed: March 31, 2000

Examiner: Joseph E. Avellino

For: PROXY INTERNET BROWSING

APPELLANT'S BRIEF ON APPEAL

Honorable Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

Appellants respectfully appeal the final rejection of claims 1, 3-5, 7-11, 15, and 17-25 in the Office Action dated February 2, 2004. A Notice of Appeal was timely filed on May 3, 2004.

I. REAL PARTY IN INTEREST

The real party in interest is Texas Instruments, Inc., assignee of 100% interest of the above-referenced patent application.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants's legal representative or Assignee which would directly affect or be

directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1, 3-5, 7-11, 15, and 17-25, all the claims in the Application are set forth fully in the attached Appendix.

1, 3-5, 7, 9, and 15, and 17-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over by Mansbery et al (U.S. Patent No. 6,121,593) in view of Reynolds (U.S. Pat. No. 6,587,879). Claims 8 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mansbery in view of Reynolds and Cuomo (U.S. Pat. No. 5,861,883). Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mansbery in view of Reynolds in view of Cuomo in view of Gabai (U.S. Pat. No. 6,368,177).

Appellant respectfully appeals the rejections of claims 1, 3-5, 7-11, 15, and 17-25.

IV. STATEMENT OF AFTER-FINAL AMENDMENT

An After-Final Amendment was filed by the Applicant. However, as of the date of this Appeal Brief, the proposed amendments were not entered by the Examiner. Therefore, the claims are pending as set forth in the Appendix.

In the After-Final Amendment, Appellant sought to amend claims 5 and 7 to overcome the 35 U.S.C. §112 rejections. Applicant intended to amend claim 5 to

recite that the configuration data is located on the Internet server. Further, Applicant intended to amend claim 7 to recite that the oven downloads the recipe file for clarification. The original claim 5 is dependent to claim 4, whereas the claim should be amended to be dependent to independent claim 1, with a proper antecedent basis to the Internet server of claim 1.

V. SUMMARY OF THE INVENTION

The invention, as set forth and defined by independent claim 1, is a system, program product, and method for proxy browsing the Internet. In an exemplary embodiment, illustrated in Figure 2, the Proxy Browser 26 may operate to download either files from a Web page or Web pages themselves from the Internet to a remote PC 58, network 56, or electronic appliances 48-52. A client PC 52 need not communicate directly with the proxy browser 26. The proxy browser program may designate a file to download to a receiving device through a separate remote computer or network without communicating with the remote receiving device (see Application, p. 12, second full paragraph). The proxy browser 26 may designate a file located on a Web (e.g., Internet) server to download to a remote client device that is linked to the Internet using the remote client's URL, or network IP, address. An appliance connected to the Internet has an IP address/URL attached to data packets sent and received by the appliance to and from the Internet. (Application, p. 13, lines 1-6).

Conventional systems for transmitting a data file through the Internet to an endpoint, such as a networked electronic appliance or computer, use a computer on a remote network to control the transmission of a data file or command to the remote appliance or computer. This is accomplished by using TCP/IP to control the structure and flow of information transmitted between the sending computer and the receiving computer or device. Internet Protocol is responsible for recognizing the source and destination addresses in connection and with insuring receipt of data packets at the proper location, as well as checking for the accuracy of data packets sent and received. Either or both ends of the transmission may be located on a local area network and use additional local network protocols to complete the data transmissions.

The present invention, however, provides Internet browsing by proxy, whereby a user on a computer executes the proxy browser and causes remote Internet-linked servers to interact with alternate remote client devices that are linked to the Internet. After a command containing the client device's IP address (URL) is sent to a server, interaction may occur between the remote server and client device without interaction or communication with the proxy browser and the remote client device.

The non-obvious and unique combination of features includes "said Proxy Browser transmits a command with said electronic appliance IP address through

the Internet that directs an Internet server to transmit a remote digital file selected by said Proxy Browser program to said electronic appliance IP address," as recited in claim 1. In exemplary embodiments described in the Application, Figures 4 and 5 illustrate exemplary commands for a proxy browser to send commands to an Internet server and have the server download the files or Web pages to client appliances or PCs. The user selects a file from an Internet server or a Web page to download to an alternative client appliance or computer 124. The user 120 then either selects from a list of saved URLs or IP addresses for each device or enters a new URL 130 and records the type and name of the client device. Further, the server determines the correct TCP socket assigned to the device and transmits the proxy file through to the device's networking interface. When the transmitted file reaches the device or computer, the file is saved or executed depending upon the type of client device. (see Application, p. 16, paragraph 1).

The invention further comprises "said Proxy Browser transmits a command . . . without said electronic appliance communicating with said proxy browser," as recited in claim 1. In the exemplary embodiment, the the user 120 may either select from a list of saved URLs or IP addresses for each client device or enters a new URL 130 and records the type and name of the client device. The Proxy Browser does not require verification of the URL of the client device to send a file or command by proxy. The (Internet) server determines the correct TCP socket assigned to the device and transmits the proxy file through to the device's

networking interface. (Application, p. 15, lines 14-30).

The present invention further provides for “said digital file executes on said electronic appliance without verification of said digital file execution by said proxy browser program,” as recited in claim 1. In an exemplary embodiment, when the transmitted file is received by a client device or computer, the file is saved or executed depending upon the type of client device. (Application, p. 16, lines 8-10).

VI. ISSUES PRESENTED FOR REVIEW

The issues presented for review by the Board of Patent Appeals and Interferences is:

Whether claims 1, 3-5, 7-11, 15, and 17-25 are unpatentable under 35 U.S.C. §103(a), and whether claims 5 and 7 are indefinite under 35 U.S.C. § 112, second paragraph.

VII. GROUPING OF THE CLAIMS

As supported by the following arguments, independent claims 1, 15, 18, and 21 are each independently patentable and do not stand or fall together.

Claim 1 recites:

A system for proxy browsing the Internet, comprising:

a first computer linked to the Internet;

a Proxy Browser Internet interface program hosted on said Internet linked computer; and

an electronic appliance linked online to the Internet, wherein said electronic appliance comprises a unique Internet Protocol (IP) address, and said electronic appliance can actively receive electronic data transmissions from the Internet,

wherein said Proxy Browser transmits a command with said electronic appliance IP address through the Internet that directs an Internet server to transmit a remote digital file selected by said Proxy Browser program to said electronic appliance IP address without said electronic appliance communicating with said proxy browser, and said digital file executes on said electronic appliance without verification of said digital file execution by said proxy browser program.

However, unlike independent claim 1, claim 15 is a program product to that performs the claimed invention. For example, claim 15 recites a “proxy browser program located on a processor of a first computer, said proxy browser processing data from a plurality of hypertext markup language (HTML) pages, said proxy browser program comprising at least one language code source to make at least one function call to retrieve data from an HTML page on a remote Internet server.” Retrieving data from an HTML page on a remote Internet server is not an element of claim 1. Further, the claim element of “data from said function call displays on a video screen” is not an element of claim 1.

Independent claim 18 is a computer-implemented method for proxy

browsing that recites. Claim 18 recites “invoking said proxy browser program on said first computer to direct said Internet server to cause a transmission of at least one remote digital file, located on a second Internet server , using a Uniform Resource Locator (URL) of said second computer,” which is unlike the claim 1 element of transmitting a command to an “electronic appliance” using an “electronic appliance IP address.”

Further, independent claim 21 is a method for proxy browsing the Internet using the system of claim 1.

In addition, each of the dependent claims is patently distinct from the independent claims from which they depend. More specifically, dependent claims 3-5, 7-11 and 19-20 are patently distinct from independent claim 1. Further, dependent claims 17 and 24 are patentably distinct from independent claim 15, claim 25 is patentably distinct from claim 18, and claims 22-23 are patentably distinct from claim 21, from which the respective claims depend

Each dependent claim recites additional features, not defined in the respective independent claim. As discussed in greater detail below, the features defined by the dependent claims are not merely illustrations or examples, but patentable features which prevent the dependent claims from standing or falling with independent claims 1, 15, 18, and 21.

VIII. ARGUMENT

THE MANSBERY AND REYNOLDS REFERENCES

The Examiner has not issued an After-final Office Action in this case. In the First and Final Office Actions issued during prosecution of the present Application, the Examiner rejected every claim based on mere conclusory statements of obviousness. Appellant overcame the first rejections of obviousness in the July 30, 2003 Non-Final Office Action, which caused the Examiner to cite additional, new art and issue new rejections in the Final Office Action. Appellant objects as prejudicial to the citation of new art for the first time in the Final Office Action. In the Final Office Action, the Examiner alleges that Mansbery would have been combined with Reynolds to form the claimed invention. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Regarding all of the pending claims, the Examiner has repeatedly failed to provide evidence of a suggestion, teaching, or motivation to combine the cited references. In the Final Office Action, the Examiner has failed to state a reason that one skilled in the art at the time the invention was made would combine the teaching of Mansbery and Reynolds to produce the claimed invention (the Examiner's alleged combination of Mansbery and Reynolds serves as the basis for all of the claim rejections in the Final Office Action). The Examiner has attempted

to identify in separate pieces of prior art each individual part claimed in the Application. This is insufficient to defeat patentability of the whole claimed invention. See *In Re Werner Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). In *Kotzab*, the Federal Circuit admonished that "Close adherence" to analyzing the patentability of claims pursuant to section 103(a) by casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field is "especially important in cases where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id.* (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. (BNA) 303, 313 (Fed. Cir. 1983)).

As will be described more fully below, the Examiner "fell into the hindsight trap." *Kotzab* at 1371. As the case law makes clear the way to avoid the "subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See *In Re Anita Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999); see also *Graham v. John Deere Co.*, 383 U.S. 1, 18, 148 U.S.P.Q. (BNA) 459, 467, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966) ("strict observance" of factual predicates to obviousness conclusion required). This, the Examiner failed to do. Combining prior art references without evidence of such a

suggestion, teaching, or motivation simply takes Appellant's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. *Dembiczak*, 175 F.3d at 999; See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 U.S.P.Q. (BNA) 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). The Examiner has failed to make a requisite showing of the teaching or motivation to combine the prior art references. The present obviousness rejections are impermissible and should be withdrawn. Appellant respectfully requests the Board to reverse the obviousness rejection to claim 1, as well as all of the rejections cited above, and order that the present Application be passed to issue.

Claim 1 recites:

A system for proxy browsing the Internet, comprising:

a first computer linked to the Internet;

a Proxy Browser Internet interface program hosted on said Internet linked computer; and

an electronic appliance linked online to the Internet, wherein said electronic appliance comprises a unique Internet Protocol (IP) address, and said electronic appliance can actively receive electronic data transmissions from the Internet,

wherein said Proxy Browser transmits a command with said electronic appliance IP address through the Internet that directs an Internet server to transmit

a remote digital file selected by said Proxy Browser program to said electronic appliance IP address without said electronic appliance communicating with said proxy browser, and said digital file executes on said electronic appliance without verification of said digital file execution by said proxy browser program.

In the Final Office Action, the Examiner alleged that

Mansbery does not disclose that the address of the electronic appliance is an IP address and said electronic appliance can actively receive electronic data transmissions from the Internet. In analogous art, Reynolds discloses another system for proxy browsing the Internet wherein the electronic appliance (i.e. refrigerator, microwave, etc.) includes a network address, such as an IP address (col. 3, lines 20-25, 60-63), and said electronic appliance can actively receive electronic data transmissions from the Internet (col. 4, line 25 to col. 5, line 11).

It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Reynolds with Mansbery to allow testing of remote devices having limited processing capabilities, such as consumer appliances and other types of electronic devices, thereby reducing the need of sending a service representative to the appliance to determine if the appliance is malfunctioning as supported by Reynolds (col. 1, lines 15-25, 45-50) (Final Office Action, p. 4).

This is a flawed analysis of combining prior art references to produce the claimed invention. The Examiner has alleged that combining Mansbery with Reynolds will produce the disclosure of Reynolds. Combining Reynolds with Mansbery in order to create the disclosure of Reynolds (e.g., allow testing of remote appliances to prevent a service technician) is an improper reason to combine with Mansbery and does not make sense. The alleged combination, which would only produce the disclosure of Reynolds, adds no disclosure to either Reynolds or

Mansbery that would teach Applicant's claimed invention.

Further, there is no teaching or suggestion in Mansbery to combine with Reynolds in order for "testing of remote devices having limited processing capabilities, such as consumer appliances and other types of electronic devices, thereby reducing the need of sending a service representative to the appliance to determine if the appliance is malfunctioning" as described by the Examiner. Mansbery discloses "to provide a food heating and cooling unit, which may be actuated from a remote location" and to "actuate home appliances from a remote location utilizing a specific method and mechanism of doing so." (col. 1, lines 40-48). As is clear, Mansbery is directed towards heating and cooling a consumer appliance remotely and does not suggest Reynold's purpose of replacing a service technician by performing a test of a consumer appliance from a remote location. In such a combination, one skilled in the art would recognize that Mansbery is unnecessary and adds nothing to Reynolds produce the teachings of Reynolds.

The Examiner has failed to make a requisite showing of the teaching or motivation to combine the prior art references. The Examiner has merely stated that "it would have been obvious to one of ordinary skill in the art at the time" to combine the references. Rather than pointing to specific information in Mansbery or Reynolds that suggests the combination of the elements of the claimed invention, the Examiner instead described in detail the similarities and advantages

between the references and the claimed invention, noting that one reference or the other--in combination with each other--described all of the limitations of the pending claims. Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the references, nor does the Examiner make specific--or even inferential--statements concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other facts that might serve to support a proper obviousness analysis. See *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2D (BNA) 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 U.S.P.Q. (BNA) 657, 667 (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). See also *Graham*, 383 U.S. at 18, 148 U.S.P.Q. (BNA) at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining *Mansbery* with *Reynolds*, without evidence of such a suggestion, teaching, or motivation simply takes Appellant's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227

U.S.P.Q. (BNA) 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.").

Although it is well known that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 U.S.P.Q.2D (BNA) 1626, 1630 (Fed. Cir. 1996), "the suggestion more often comes from the teachings of the pertinent references," *Rouffet*, 149 F.3d at 1355, 47 U.S.P.Q.2D (BNA) at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. Here, the Examiner has cited no such evidence. That is, the showing must be clear and particular. *Dembiczak*, 175 F.3d at 999. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." *Id.*

Since the Examiner cannot point to a proper evidence of a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Examiner's conclusion of obviousness cannot stand. See *C.R. Bard*, 157 F.3d at 1352, 48 U.S.P.Q.2D (BNA) at 1232; *Rouffet*, 149 F.3d at 1359, 47 U.S.P.Q.2D (BNA) at 1459; *Fritch*, 972 F.2d at 1265, 23 U.S.P.Q.2D (BNA) at 1783; *Fine*, 837 F.2d at 1075, 5 U.S.P.Q.2D (BNA) at 1600; *Ashland Oil*, 776 F.2d at 297, 227 U.S.P.Q. (BNA) at 667. Thus, there is no reason one skilled in the art

would combine Mansbery with Reynolds to produce the disclosure of Reynolds, absent hindsight. The obviousness rejections for all the presently pending claims are impermissible and should be withdrawn.

Further, the Examiner has attempted to identify in separate pieces of prior art each individual part claimed in the Application. This is insufficient to defeat patentability of the whole claimed invention. See *In Re Werner Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). For Example regarding claim 1, the Examiner alleges that "Mansbery discloses a system for proxy browsing the Internet," that includes

an electronic appliance linked to a powerline network 150 which is connected to an appliance server 100 connected to the Internet, the electronic appliance comprises a unique CEBUS address on the powerline network . . .

wherein said Proxy Browser transmits a command through the Internet that directs an Internet server (i.e., "Tonight's menu Appliance server" 100) to transmit a remote digital file . . .

The Examiner then alleges that Reynolds discloses

wherein the electronic appliance (i.e. refrigerator, microwave, etc.) includes a network address, such as an IP address . . .

and said electronic appliance can actively receive electronic data transmissions from the Internet.

Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Mansbery and Reynolds references teach or suggest their combination to yield the claimed invention. To the contrary, the obviousness analysis in the Examiner's rejections are limited to a discussion of the ways that the multiple prior art references can individually be read on different elements of the

claimed invention. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) (noting the Patent and Trademark Office Board of Patent Appeals and Interferences failure to explain, when analyzing the prior art, "what specific understanding or technical principle . . . would have suggested the combination"). Most if not all inventions arise from a combination of old elements. *In Re Werner Kotzab*, 217 F.3d at 1370. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *Id.*

In all remaining rejections to the claims, the Examiner alleges the same allegations to combine Mansbery with Reynolds. Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the references, nor does the Examiner make specific--or even inferential--statements concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other facts that might serve to support a proper obviousness analysis. In each rejection, the Examiner merely states that Reynolds would be combined with Mansbery to teach the disclosure of Reynolds as described in column 1, lines 15-25 and lines 45-50 of Reynolds.

For a further example, in rejecting claim 4, the Examiner admits that Mansbery "does not specifically disclose that the embedded server in the electronic appliance is an embedded server" and that Reynolds discloses this feature. (Final

O.A., p.5). The Examiner further repeats the allegations to combine to test consumer appliances remotely to reduce the need to send a service technician to the appliance to determine if the appliance is malfunctioning. No person skilled in the art at the time of the invention would combine Mansbery with Reynolds to arrive at the teachings of Reynolds and Reynolds' replacement of a service technician adds no disclosure to Mansbery that would teach the claimed invention.

However, even if combined, the combination of Mansbery with Reynolds fails to teach or suggest the claimed invention.

The Examiner alleges Figure 2, reference numeral 200 discloses

an electronic appliance linked to a powerline network 150 which is connected to an appliance server 100 connected to the Internet, the electronic appliance comprises a unique CEBUS address on the powerline network;

wherein said Proxy Browser transmits a command through the Internet that directs an Internet server (i.e., "Tonight's menu Appliance Server 100") to transmit a remote digital file (i.e., recipe of file of commands to cook the dish selected by the user) selected by said Proxy Browser program to said electronic appliance address. (Final O.A., p. 4-5) (emphasis Applicant's).

However, these passages from Mansbery merely describe a client/server architecture where "an appliance server runs on the home server" that allows client software located on a computer on the Internet or on a home network to communicate with the appliance server 100 (Mansbery, col. 5, lines 45-65). The Examiner has alleged that appliance server 100 that is "connected to the Internet" is the same as "an Internet server (i.e., "Tonight's menu Appliance Server 100),"

which are analogized to the claimed "Internet server," "wherein said Proxy Browser transmits a command with said electronic appliance IP address through the Internet that directs an Internet server to transmit a remote digital file selected by said Proxy Browser program to said electronic appliance IP address," as recited in claim 1. This is respectfully incorrect.

The Appliance Server 100 is neither characterized nor named as an "Internet server" by Mansbery anywhere in the disclosure. This assumption has been read into the disclosure and furthermore cannot be analogized to the claimed "Internet server." In a non-limiting exemplary embodiments of the Application in Figure 2, "Web server" 40 is illustrated on Internet 38 prior to entering Applicant's home 42 that has a local area network "LAN server" 44 that controls home network through hub 46. The Web server 40 and the LAN server 44 are clearly two different devices serving different function in Applicant's invention. In Figures 3A-3D of the Application, Web servers 80, 90, 100, and 112 are illustrated with the Internet and are remote from client devices in homes 84, 94, 106, and 118, respectively.

In contrast, Mansbery discloses an appliance server "that runs on the home server" (col. 5, line 46) and contains a software called Tonight's Menu Appliance Server software 100 that "runs on the home computer" (col. 6, lines 15-17). The Server Software 100 "can communicate and operate home appliances 200." (Mansbery, col. 6, lines 40-41). "The Tonight's Menu Appliance Server Software

100 receives information from the internet and translates this information into specific commands to operate the home appliances 200.” (Mansbery, col. 6, lines 22-25) Figure 2 of Mansbery illustrates the “Tonight’s Menu Appliance Server” as the “Home Complex” 100, which is separate and distinct from the “Internet” which is labeled without a reference numeral.

There is no teaching or suggestion in Mansbery of “said Proxy Browser transmits a command with said electronic appliance IP address through the Internet that directs an Internet server to transmit a remote digital file selected by said Proxy Browser program to said electronic appliance IP address,” as recited in claim 1. Mansbery’s Menu Server 100 is clearly located on the home network, not the Internet. The Menu server 100 is a common home network server that merely “receives information from the internet” but is not characterized as, shown, or described as an “Internet server.” The present Application clearly shows a common home network server 44 in Figure 2 that is separate and distinct from an Internet server 40 that would “transmit a remote digital file selected by said Proxy Browser program to said electronic appliance IP address,” as recited in claim 1.

The Examiner has further alleged that the characterization of “all communication is mediated through the appliance server 100” discloses “said Proxy Browser transmits a command through the Internet that directs an Internet server . . . to transmit a remote digital file . . . selected by said Proxy Browser program to said electronic appliance address without said electronic appliance

communicating with said proxy browser." (emphasis Applicant's). However, this is an incorrect mischaracterization of Mansbery's disclosure, and in contrast to the claimed invention, Mansbery's appliances 200 exchange communications with Mansbery's remote computer 50 that is linked to the Internet. Mansbery does not disclose that "all communication is mediated through the appliance server 100" (emphasis Applicant's), and Applicant cannot determine what the Examiner defines as communication that is "mediated through" the appliance server 100.

As is clear, Mansbery discloses that the client computer 50 communicates with the appliances 200, and vice-versa. There is no teaching or suggestion of "said Proxy Browser transmits a command . . . without said electronic appliance communicating with said proxy browser," as recited in claim 1. The appliance server 100 software is the "CEBUS" operating system for home appliances 200 and merely translates the commands from the client software 50 into the "CEBUS" type of formatting so that appliances can communicate with external software. Mansbery discloses that home appliance server 100 is the operating system for each of the appliances 200, and therefore when a user communicates with the appliance server 100, the user is actually communicating with the appliance 200. Part of the purpose of each computer 21 inside each appliance 200 in Mansbery, Figure 1, is for "responding to control requests submitted via digital control from remote locations." (Mansbery, col. 3, lines 7-8).

Mansbery describes how the appliances 200 communicate with remote client

computer 50:

The present invention discloses a CEBUS Subsystem protocol 120 to communicate with the home appliances 200. The Tonight's Menu Appliance Server Software 100 receives information from the internet and translates its information into specific commands to operate home appliances 200. (col. 6, lines 20-25).

The Tonight's Menu Appliance Server Software 100 will also create a CORBA appliance object 100 for each home appliance 200 . . . (col. 6, lines 29-32)

Thus, a user on a remote computer running the Tonight's Menu Client Software 50 connected through the Internet through the CORBA appliance objects 110 to the Tonight's Menu Appliance Server Software 100 can communicate and operate home appliances 200. (col. 6, lines 37-42) (emphasis Applicant's)

Thus, although the Examiner alleges that "all" communication is "mediated" through the Appliance Server 100 means that Mansbery's appliances 200 do not communicate with a browser on remote computer 50, Mansbery discloses that "a user on a remote computer . . . can communicate and operate home appliances 200." By connecting remotely through home Appliance server 100 using Tonight's Menu Appliance Server Software 100, the appliances 200 clearly communicate with a remote Tonight's Menu Client Software 50.

Mansbery fails to teach or suggest "said Proxy Browser transmits a command with said electronic appliance IP address through the Internet that directs an Internet server to transmit a remote digital file selected by said Proxy

Browser program to said electronic appliance IP address without said electronic appliance communicating with said proxy browser,” as recited in claim 1. The claimed invention allows user to select a file to download to a remote appliance and command a remote Internet server to perform the transmission to the appliance’s unique IP address. In a non-limiting exemplary embodiment of the present invention, “The Web server 38 receives commands from the proxy browser 26 to send a file or Web page to a specific client on a network 42.” (Application, p. 12, lines 20-22) Further, the file transmission between the Web server and the client (e.g., electronic appliance) occurs “without said electronic appliance communicating with said proxy browser” which includes without a controller of the appliance being controlled by the proxy browser. In an exemplary embodiment, “The client PC 62 in the embodiment does not need to communicate directly with the Proxy Browser 26.” (Application, p. 15, lines 1-5). Thus, Mansbery’s appliances 200 communicate with Mansbery’s remote browser program 50, which is a feature negatively claimed by the claimed invention.

Further, the Examiner alleges that Figure 9 and “the appliance server 100 of Mansbery does not notify the client software/browser that the download has been completed, merely just begins executing the digital recipe file” discloses “said Internet server verifies said IP address and verifies a transmission of said remote digital file without interaction of said proxy browser program,” as recited in claim 3 (emphasis Applicant’s). The Examiner is respectfully incorrect. Column 9, lines 1-

30 of Mansbery clearly show that "Information regarding a particular button that was pressed by the user will be transmitted from the Tonight's Menu Client Software 50 to the Tonight's Menu Appliance Server Software 100," and that "The Tonight's Menu Appliance Server Software 100 will notify the user that it has successfully received the user's remote button command."

THE CUOMO REFERENCE

The Examiner further alleges that claims 8 and 10 are obvious over Mansbery and Reynolds in view of Cuomo. The same arguments above apply to this rejection. Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the references, nor does the Examiner make specific--or even inferential--statements concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other facts that might serve to support a proper obviousness analysis. In each rejection, the Examiner states that Cuomo would be combined with Mansbery and Reynolds to for reasons unrelated to the claimed invention, and further for reasons unrelated to Mansbery and/or Reynolds.

However, the Examiner's reasons to combine are also flawed and thus the alleged combination with Cuomo cannot stand. The Examiner stated that the references would have been combined "to ensure a master computer is appropriately synchronized with following client computers as stated in Cuomo (col.

5, lines 47-55).” (Final Office Action, p. 7-8, paragraphs 13-14). However, the present invention does not claim or discuss “synchronizing” a master computer with client computers as described in Cuomo. The claimed invention, in claim 8, recites a “digital speaker online to the Internet and associated with a unique IP address” so that a proxy browser can select a music file from an Internet server, after which the music file is downloaded from the server and played on the speaker.

Synchronizing an online speaker with a master computer (which is assumed to be the Examiner’s analogy to an Internet server) is distinguished from, and cannot render obvious, downloading a file using a proxy browser and simply playing out the music file on a speaker. Claim 11 follows similarly for a video file.

Thus, Cuomo would not have been combined with Mansbery and Reynolds to teach the claimed invention, and even if combined, would not teach or suggest the claimed invention.

THE GABAI REFERENCE

The Examiner further alleges that claim 11 is rejected over Mansbery and Reynolds in view of Cuomo in view of Gabai. The same arguments above apply to this rejection. Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the references, nor does the Examiner make specific--or even inferential--statements concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or

any other facts that might serve to support a proper obviousness analysis. In each rejection, the Examiner states that Gabai would be combined with Mansbery and Reynolds for reasons unrelated to the claimed invention, and further for reasons unrelated to Mansbery and/or Reynolds.

However, the Examiner's reasons to combine are also flawed and thus the alleged combination with Gabai cannot stand. The Examiner stated that the references would have been combined "to provide messages to the user which can be used for effecting sales over the Internet as stated by Gabai (col. 2, lines 25-40)." (Final Office Action, p. 9, paragraph 15). However, the present invention does not claim or discuss "sales over the Internet" for any reason. The claimed invention, in claim 11, recites "wherein said Proxy Browser selects a digital game configuration file from said Internet server, said digital configuration game file is downloaded to a game or toy that is linked to the Internet, and said game file reconfigures said game or toy to provide new scenarios and strategies for entertainment." Effecting sales over the Internet is an unrelated analogy to the claimed invention and is distinguished from, and cannot render obvious, downloading a file using a proxy browser to reconfigure a game or toy with digital files.

IX . CONCLUSION

In view of the foregoing, Appellants submit that claims 1, 3-5, 7-11, 15, and

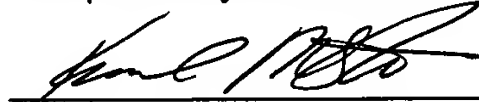
Appellants' Brief on Appeal
09/540,558

17-25, all the claims presently pending in the application, are patentably distinct from the prior art of record and in condition for allowance. Thus, the Board is respectfully requested to remove the rejections of claims 1, 3-5, 7-11, 15, and 17-25 and pass the present Application to issue.

Please charge any deficiencies and/or credit any overpayments necessary to enter this paper to Client's Deposit Account number 20-0668.

Dated: 7-2-04

Respectfully submitted,



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APPENDIX

1. A system for proxy browsing the Internet, comprising:
 - a first computer linked to the Internet;
 - a Proxy Browser Internet interface program hosted on said Internet linked computer; and
 - an electronic appliance linked online to the Internet, wherein said electronic appliance comprises a unique Internet Protocol (IP) address, and said electronic appliance can actively receive electronic data transmissions from the Internet, wherein said Proxy Browser transmits a command with said electronic appliance IP address through the Internet that directs an Internet server to transmit a remote digital file selected by said Proxy Browser program to said electronic appliance IP address without said electronic appliance communicating with said proxy browser, and said digital file executes on said electronic appliance without verification of said digital file execution by said proxy browser program.
2. (Canceled)
3. A system for proxy browsing the Internet according to claim 1, wherein said

Proxy Browser Internet interface program identifies said remote digital file and identifies an IP address of said electronic appliance, and

said Internet server verifies said IP address and verifies a transmission of said remote digital file without interaction of said proxy browser program.

4. A system for proxy browsing the Internet according to claim 1, further comprising:

an embedded Internet server located in said electronic appliance comprising configuration data and operating status data for said electronic device.

5. A system for proxy browsing the Internet according to claim 4, wherein said configuration data is located within the Internet server.

6. (Canceled)

7. A system for proxy browsing the Internet according to claim 1, wherein said Proxy Browser program selects a digital recipe file from said Internet server to download to said electronic appliance,

wherein said home electronic appliance is an oven, and

said server downloads said recipe file such that when said recipe file is executed, said oven is configured with baking instructions from said digital recipe

file.

8. A system for proxy browsing the Internet according to claim 1, further comprising:

a digital speaker online to the Internet and associated with a unique IP address,

wherein said Proxy Browser program selects a digital music file from said Internet server and sends said command to download said digital music file to said digital speaker IP address, and

said music file is downloaded and played on a said digital speaker.

9. A system for proxy browsing the Internet according to claim 1, wherein said Proxy Browser program selects an Internet Web page, and

said Web page is downloaded by said server into an embedded Internet server on said electronic appliance.

10. A system for proxy browsing the Internet according to claim 1, wherein said Proxy Browser program selects a digital video file from said Internet server, and

said Internet server downloads said digital video file onto a digital video player that is connected to the Internet.

11. A system for proxy browsing the Internet according to claim 1, wherein said Proxy Browser selects a digital game configuration file from said Internet server, said digital configuration game file is downloaded to a game or toy that is linked to the Internet, and said game file reconfigures said game or toy to provide new scenarios and strategies for entertainment.

12-14. (Canceled)

15. A program product comprising:
a proxy browser program located on a processor of a first computer, said proxy browser processing data from a plurality of hypertext markup language (HTML) pages, said proxy browser program comprising at least one language code source to make at least one function call to retrieve data from an HTML page on a remote Internet server, said data from said function call displays on a video screen;
at least one configuration file on said processor of said first computer containing an Internet Protocol address of a second computer that is not networked to said first computer, wherein said proxy browser program transmits a command to said Internet server, said command directing said Internet server to transmit a remote digital file to said IP address of said second computer, said Internet server

transmits said digital file to said IP address without said second computer communicating with said proxy browser program.

16. (Canceled)

17. The program product according to claim 15, wherein said second computer comprises an electronic appliance having at least one central processor, memory coupled to said processor, and Internet networking capability.

18. A computer-implemented method for proxy browsing, comprising:
providing, on a first computer a processor capable of reading and executing a proxy browser program, a networking configuration linking to the Internet and processing function calls to an Internet server;

providing, on a second computer, a processor and memory coupled to said processor with the ability to transmit and receive digital files transmitted through the Internet;

invoking said proxy browser program on said first computer to direct said Internet server to cause a transmission of at least one remote digital file, located on a second Internet server, using a Uniform Resource Locator (URL) of said second computer;

transmitting said remote digital file from said second Internet server to said

~~third~~ second computer without said second computer communicating with said proxy browser program; and

processing said transmitted digital file on said second computer and performing output functions according to a format and language of said digital file.

19. The system of claim 1, wherein said Internet server transmits said remote digital file to said electronic appliance IP address without said verification of said IP address or said file transmission by said proxy browser program.

20. The system of claim 1, wherein said proxy browser program transmits a command to said Internet server that directs said server to transmit said remote digital file to a uniform resource locator address of said electronic appliance, said remote digital file transmission occurring without interaction or verification by said proxy browser program.

21. A method for proxy browsing the Internet, comprising:
linking a first computer to the Internet;
hosting a proxy browser program;
connecting an electronic appliance online to the Internet, said electronic appliance can actively receive electronic data transmissions from the Internet;
transmitting a command from said proxy browser program to an Internet

server said command directing said Internet server to transmit a remote digital file to an Internet Protocol (IP) address of said electronic appliance;

transmitting said digital file to said IP address without said electronic appliance communicating with said proxy browser program; and

executing said digital file on said electronic appliance without verification of said executing by said proxy browser program.

22. The method of claim 21, wherein said transmitting said digital file comprises transmitting said remote digital file to said electronic appliance IP address without verification of said IP address or file transmission by said proxy browser program.

23. The system of claim 21, wherein said transmitting a command from said proxy browser program comprises transmitting a command to said Internet server that directs said server to transmit said remote digital file to a uniform resource locator address of said electronic appliance, said remote digital file transmission occurring without interaction with, or verification by, said proxy browser program.

24. The program product of claim 15, wherein said digital file executes on said electronic appliance without verification of said execution by said proxy browser program.

25. The method of claim 18, wherein said transmitting comprises transmitting a command to said first Internet server that directs said first Internet server to transmit said remote digital file to said uniform resource locator address of said second computer without interaction or verification by said proxy browser program.